

FEB 27 2009


Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)

Approved for use through 02/28/2009, OMB 0651-0031

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1630-0455PUS1	
		Application Number 10/769,813-Conf. #9550	Filed February 3, 2004
		First Named Inventor Jong LEE	
		Art Unit 2827	Examiner T. X. Dinh
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 40,953</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p style="text-align: right;">  Signature Esther H. Chong Typed or printed name (703) 205-8000 Telephone number February 27, 2009 Date </p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>			

FEB 27 2009

Docket No.: 1630-0455PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jong LEE

Application No.: 10/769,813

Confirmation No.: 9550

Filed: February 3, 2004

Art Unit: 2627

For: APPARATUS AND METHOD FOR
DETERMINING TYPE OF OPTICAL DISK

Examiner: T. X. Dinh

REQUEST FOR PRE-APPEAL CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

REMARKS

Applicants hereby request a pre-appeal conference with respect to the Office Action dated December 1, 2008, in which pending claims 14 and 15 continue to be rejected. A Notice of Appeal is being filed herewith.

BACKGROUND

Because the claims under rejection have been at least twice rejected, it is proper to Appeal the rejection of claims 1-11 and 14-17, pursuant to 35 USC §134(a).

The rejections of claims 14 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2004/0218497 to Choi et al. ("Choi"), and as being rejected under 35 USC §102(e) as being anticipated by U.S. Patent Application Publication 2004/0130991 to

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Tawaragi have been withdrawn by the Advisory Action dated February 18, 2009, and will not be discussed further.

Claims 1-11, 16 and 17 have been allowed.

I. GROUNDS OF OBJECTION AND REJECTION TO BE REVIEWED

A. Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,859,425 to Maegawa et al. ("Maegawa").

II. ARGUMENTS

Claim 14 recites a method for determining the type of an optical disk that is loaded into an optical disk device, comprising loading the optical disk into the optical disk device; determining initially a type of the loaded optical disk; activating a focusing servo based on the initial determination result; detecting a level of a wobble extraction signal while the focusing servo is activated and a tracking servo is turned off; determining finally the type of the loaded optical disk based on the detected wobble extraction signal level; and performing a tracking servo adjustment operation according to the finally determined type of the loaded optical disk.

Claim 15 recites an apparatus for determining the type of an optical disk loaded into an optical disk device, comprising means for loading the optical disk into the optical disk device; means for determining initially a type of the loaded optical disk; means for activating a focusing servo based on the initial determination; means for detecting a level of a wobble extraction signal while the focusing servo is activated and a tracking servo is turned off; means for determining finally the type of the loaded optical disk based on the detected wobble extraction signal level; and means for performing a tracking servo adjustment operation

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according to the finally determined type of the optical disk.

The Office Action states that Maegawa determines the type of the loaded optical disk based on the detected wobble extraction signal, indicating that disclosure of this feature is found in col. 32, lines 5-40.

Applicant strenuously disagrees with this conclusion because nowhere in Maegawa is there any explicit or inherent (which requires not just a possible disclosure, and not just a probable disclosure, but a necessary disclosure) teaching of determining the type of loaded disk based on the detected wobble signal. Inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In col. 32, lines 5-40, Maegawa discloses details of its wobble detection circuit and states that it may be applied to a plurality of types of recording media. Maegawa is directed to extracting a wobble signal with high accuracy regardless of the difference characteristics between different types of optical recording media including differences in laser light power for forming the optical recording media space region and for forming the optical recording media mark region (col. 5, line 51 to col. 5, line 35). However, there is no disclosure whatsoever in Maegawa of using the wobble signal to determine what type of media is being loaded into the optical disk device.

Maegawa only discloses using the wobble signal in conjunction with extracting ADIP information from the wobble signal, providing the extracted ADIP information to the CPU 40 and when, based on the error detection code or the like attached to the ADIP information, the decoder 31 determines that ADIP information includes an error, the decoder 31 reports the error

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detection in the ADIP information to the CPU 40. The CPU 40 measures the error rate of the error detected in the ADIP information, and when the error rate becomes larger than a predetermined value, the CPU 40 stops the data reproducing operation, and reports this fact to the host device.

In fact, the Office Action admits that Maegawa does not specifically show the step of performing a tracking servo adjustment operation according to the finally determined type of loaded disk, and concludes that "[H]owever, the optical disk detecting system of Tawaragi capable of detecting between CD-ROM, DVD-ROM, CD-R/RW or DVD-R/RW in order to perform recording of reproducing operations on this type, obviously, the tracking servo must be adjusted depend on the type of the optical recording medium as claimed."

Although Applicants asked for clarification as to the basis of this rejection., because it is not clear whether it is on MAEGAWA alone or TAWARAGI alone or some combination of both of these cited references, the substance of this issue was not addressed in the Advisory Action, contrary to the requirement to do so in MPEP §707.07(f).

Not only is the basis of the rejection in terms of what reference(s) is/are being relied on, but the Office Action is taking official notice of the tracking servo feature. This is improper for a number of reasons.

In this regard, Applicant notes the decision in *In re Boon*, 169 USPQ 231 (CCPA 1971), which points out that the Office must provide a specific reference in support of the grounds used to reject a claim and, in this regard, states that the Office may not judicially notice factual grounds for a rejection unless those facts are supported by a standard reference work and play a minor role, i.e., serving only to fill in gaps in the Office's evidentiary showing in support of a particular ground for rejection.

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No reference has been provided to support the Examiner's conclusion, and this conclusion is a major part of the rejection, not a minor role part of the rejection.

Applicants note that the Examiner also failed to address the substance of this argument in the Advisory Action, contrary to the requirement to do so in MPEP §707.07(f).

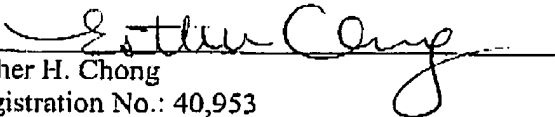
Thus, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 14 and 15.

In view of the above remarks, applicant believes this rejection of claims 14 and 15 should be reversed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: February 26, 2009

Respectfully submitted,

By 
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